UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/416,252	10/12/1999	DAVID R. TUSHIE	457.003US3	5923

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EXAMINER
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ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-44* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

  If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____ .

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

  a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Status of the claims

1.   Claims 25-44 are pending. No claims are amended, canceled, or added.

Response to Arguments

2.   Applicant's arguments filed June 24, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that Dethloff et al. (U. S. Patent 4,968,873) does not teach "acquiring personalization equipment characteristics for particular personalization equipment", at column 16 line 14-35, Dethloff teaches card issuing machine, the card, and their associated functions, which correspond to this claimed limitation.

In response to applicant's argument that Dethloff does not teach "translating the internal script into a data stream in accordance with the personalization equipment characteristics", the interactions among the card user, the card, and the card machine of Dethloff's teaching corresponds to this claimed limitation.

All other arguments regarding to the teachings of Dethloff are based on the two arguments above, and examiner maintains the original rejections.

Regarding to the double patenting rejections, it will be withdrawn upon filing of a terminal disclaimer.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 25-44 are rejected under 35 U.S.C. 102(e) as being anticipated by

Dethloff et al., U. S. Patent No. 4,968,873.

As per claim 25, Dethloff teaches a method in a personalization system of

processing data for a portable programmed data carrier comprising (abstract):

a) acquiring personalization data for a cardholder (column 9 line 59-61);

b) acquiring personalization equipment characteristics for particular

personalization equipment (column 16 line 14-35 and Figs. 17, 19-20);

c) creating instructions for an internal script from the personalization data

(abstract and Figs. 18, 21);

d) translating the internal script into a data stream in accordance with the

personalization equipment characteristics (abstract and Figs. 18, 21).

As per claim 26, Dethloff teaches transferring the data stream to the particular

personalization equipment to issue the data carrier (Figs. 15-21).

As per claim 27, Dethloff teaches creating the instructions comprises mapping

the personalization data into a plurality of variables for the instructions (Figs. 9-14, 18).

As per claim 28, Dethloff teaches translating the internal script into a data stream

comprises translating the instructions into personalization equipment program

commands specified by the personalization equipment characteristics (Figs. 17-21).

As per claim 29, Dethloff teaches the internal script specifies a sequence in which the program commands will be performed by the personalization equipment (Figs. 17-21).

As per claim 30, Dethloff teaches acquiring information for a card application, and wherein at least one of the plurality of variables holds data for the card application (column 14 line 37 – column 15 line 63 and Figs. 11-13).

As per claim 31, Dethloff teaches the internal script includes instructions for a card operating system and further comprising:

a) acquiring programming control commands for a card operating system (abstract and Figs. 18, 21);

b) translating the instructions for the card operating system into the programming control commands (abstract and Figs. 18, 21).

As per claim 32, Dethloff teaches the internal script specifies a sequence in which the programming control commands will be executed by the card operating system (column 12 line 45-50 and Fig. 9).

As per claim 33, Dethloff teaches acquiring a security function, and adding the security function to the internal script (column 12 line 51-65 and Fig. 9 and Fig. 18 and Fig. 21).

As per claim 34, the instructions for the internal script are specified in a set of database records is inherent for such system.

As per claim 35, Dethloff teaches a computer-readable medium having stored thereon instructions to cause a computer to perform a method to issue a portable

programmable data carrier, the method comprising (column 15 line 64 – column 16 line 13):

   a) determining if cardholder data is in an internal format is inherent for such system;

   b) interpreting cardholder data into a internal format if it is not in the internal format (column 5 line 41-46);

   c) mapping the internal format of the cardholder data into a plurality of data fields used by a card application (Fig. 9-14 and Fig. 18);

   d) creating a plurality of program commands for a particular personalization equipment using the data fields (Fig. 18);

   e) streaming the plurality of program commands to the particular personalization equipment to issue the portable programmable data carrier (Fig. 15-16 and Fig.18).

As per claim 36, Dethloff teaches the plurality of program commands reference data defining a microprocessor chip structure (column 1 line 28-30 and column 2 line 56-63 and column 10 line 56 – column 11 line 27 and Fig. 2).

As per claim 37, Dethloff teaches streaming programming control commands for a card operating system to the particular personalization equipment (Fig. 15-16 and Fig.18).

As per claim 38, Dethloff teaches a computer system comprising:

   a) a processing unit (Fig. 17 and Fig. 20);

b) a computer-readable medium communicatively coupled to the processing unit
(column 11 line 59 – column 12 line 5);

c) a smart card personalization system executing in the processing unit from the
computer readable medium, wherein the smart card personalization system
causes the processing unit to acquire a smart card definition, a card application
definition, program commands for a particular personalization equipment, and
cardholder data, and further causes the processing unit to map the cardholder
data into data fields specified by the card application definition to create a script,
to interpret the script into the program commands using the smart card definition,
and to transfer the program commands to the particular personalization
equipment to issue a smart card (Figs. 15-21).

As per claim 39, Dethloff teaches the smart card personalization system further
causes the processing unit to acquire a format definition and to translate the cardholder
data into a format specified by the format definition (Figs. 18, 21).

As per claim 40, Dethloff teaches the smart card personalization system further
causes the processing unit to acquire a card operating system definition and to interpret
the script into programming control commands specified by the card operating system
definition (Figs. 18, 21).

As per claim 41, Dethloff teaches the smart card personalization system further
causes the processing unit to acquire a security function and to add the security
function into the script (column 12 line 51-65 and Figs. 9, 18, 21).

As per claim 42, Dethloff teaches a computer-readable medium having stored thereon a smart card framework data structure comprising (Fig. 2):

a) a chip field containing data representing an identifier for a microprocessor in the smart card (column 11 line 5-6 and Fig. 9);

b) a master file field containing data representing information for the microprocessor identified by the chip field (column 11 line 7-8 and Fig. 9);

c) a system file field containing data representing an address for a file in the microprocessor identified by the chip field is taught by Dethloff as authenticate users (Fig. 9);

d) an equipment field containing data representing an identifier for personalization equipment used by a personalization system to program the microprocessor identified by the chip field is taught by Dethloff as issuing user a smart card and transaction is processed if the PIN number is correct (Figs. 9, 17-21)

As per claim 43, Dethloff teaches the computer-readable medium further comprising: an application field containing data representing an identifier for an application to be programmed into the microprocessor identified by the chip field (column 11 line 59 – column 12 line 5 and column 13 line 4-23 and Fig. 4a).

As per claim 44, Dethloff teaches the computer-readable medium further comprising: a security field containing data representing a security function for the application, identified by the application field (column 12 line 51 – column 13 line 64 and Fig. 9-11).

Double Patenting

5.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
         A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
         Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6.   Claims 25-44 is rejected under the judicially created doctrine of double patenting over claims 1-26 of U. S. Patent No. 5,889,941 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

         The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: acquiring personalization equipment characteristics for particular personalization equipment and transferring the data stream to the particular personalization equipment to issue the data carrier.

7.   Claims 25-44 is rejected under the judicially created doctrine of double patenting over claims 1-13 of U. S. Patent No. 6,014,748 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

         The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming

common subject matter, as follows: acquiring personalization equipment characteristics

for particular personalization equipment and transferring the data stream to the

particular personalization equipment to issue the data carrier.

8.   Furthermore, there is no apparent reason why applicant was prevented from

presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158

USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

9.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mary Cheung whose telephone number is (703)-305-

0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to

5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-308-
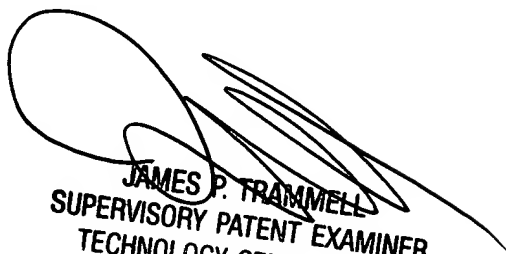
1113.

The fax phone number for the organization where this application or proceedings

is assigned are as follows:

>   (703) 872-9306   (Official Communications; including After Final
>
>   Communications labeled "BOX AF")
>
>   (703) 746-5619   (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal

Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
September 22, 2003

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